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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/888,462	07/07/1997	CURTIS R. SCHARF	2730-01	2198

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PATENT ADMINISTRATOR
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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 02/05/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 08/888,462		Applicant(s) SCHARF ET AL.	
Examiner Ellen M McAvoy		Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____ |

Continued Prosecution Application

The request filed on 22 January 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/888,462 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4-29 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al (4,594,378).

As set forth in previous office actions, Tipton et al ["Tipton"] teach polymeric compositions which exhibit improved shear stability in transmission and hydraulic fluids while maintaining high and low temperature viscosity characteristics. The polymeric compositions comprise a mixture of (A) at least one oil-soluble polymer, (B-1) at least one nitrogen-containing ester of a carboxy-containing interpolymers and/or (B-2) at least one oil-soluble acrylate polymerization product of at least one acrylate ester. The polymeric component (A) may comprise homopolymers prepared from C₃ -C₂₀ monoolefins such as butene and isobutene. See column 3, lines 4 et seq. Number average molecular weights (Mw) of such polymers range from about 500 to about 100,000, and are preferably in the range of about 750 to about 10,000. See column 2, lines 55-65 and the claims. The examiner maintains the position that independent

claims 1 and 13 which limit polymer component (A) to one having a Mw less than 50,000 still fails to distinguish this component over Tipton where a polymer having such a Mw is still encompassed. The acrylate polymerization product, component (B-2), may comprise polyacrylates (when $X=H$) and polymethacrylates (when $X=CH_3$) as set forth in col. 4, lines 25-30. Components (A) and (B-2) of Tipton clearly encompass component (A) of the instant claims which may comprise mixtures of polymer component and Tipton teaches that components (A) and (B-2) combined add to 0.2% to about 30% by weight in either a transmission fluid or a hydraulic fluid. This overlaps the range of 15-40% by weight of the instant claims, which has now amended in claim 1 to an amount of from 20% to about 40%. The polymeric compositions of the prior art may also comprise component (C), at least one low temperature viscosity-reducing liquid organic diluent such as naphthenic oil, alkylated aromatic oils and synthetic carboxylic acid ester oils. See column 18, line 13 to column 19, line 8. The diluent component of Tipton may be present in the composition in an amount of about 1% to about 35% by weight which encompasses the claimed range of about 10% to about 30% by weight for this component. This clearly encompasses fluidizing agent (B) of the instant claims.

The base oils used in preparing the transmission fluids and the hydraulic fluids of Tipton may comprise either natural oils or synthetic oils. Mineral lubricating oils are set forth as an example of a preferred natural oil. See column 23, lines 36 et. seq. Tipton also allows for the addition of conventional lubricant additives to the composition in conventional amounts and include detergent/dispersants, extreme pressure agents, anti-wear agents and oxidation inhibitors. See column 19, lines 24 to column 23, top. This clearly encompasses components (C), (D) and (E) of the instant claims. Thus, the examiner is still of the position that the composition of the instant claims is encompassed by the prior art to Tipton.

Claim Rejections - 35 USC § 103

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paboucek (5,217,636).

Paboucek discloses mineral base oil compositions into which is added a viscosity index improver and wear enhancer package which contains (a) 85 to 99.5% by weight of a low molecular weight ethylene-propylene copolymer, and (b) 0.5 to 15% by weight of an esterified alkenyl-vinyl polymer pour point depressant, resulting in 100% by weight total of (a) and (b), in 100 solvent neutral paraffinic oil as a diluent. The ethylene-propylene copolymers have molecular weights in the range of 6,000 to 12,000. See column 3, line 60 to column 4, line 63. Paboucek teaches that the finished oil mixture contains about 25-35% by weight of the ethylene-propylene copolymer (see abstract) and the mixture exhibits very high stability to permanent shear and little, if any, temporary shear and so maintains the viscosity required for proper wear protection. The examiner is of the position that the mineral oil composition of Paboucek clearly meets the limitations of claim 30.

Conclusion

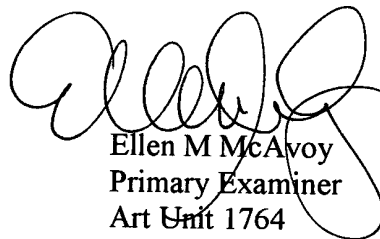
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
February 5, 2002